

AMENDMENTS TO THE DRAWINGS:

Figures 6 and 7 of the drawings have been amended to add the legend "PRIOR ART".

REMARKS

The application has been amended and is believed to be in condition for allowance.

Claims 5-9 remain in this application.

Claims 5-9 have been amended to address the Official Action's formal objections and rejections, as outlined below, and also in consideration of U.S. practice and preferences.

Claim 5 has been further amended to recite distinguishing features of the invention as supported by the specification and the drawing figures originally filed (e.g., page 6, line 26 to page 7, line 6; page 7, line 25 to page 8, line 8; Figures 3-4). These amendments to claim 5 introduce no new matter.

New claims 10-11 depend from claim 5 and further claim the invention. Claims 10-11 find support in the specification and the drawing figures as originally filed (e.g., Figures 1, 3-4) and do not introduce new matter.

New claims 12-14 further claim the invention, reciting the features of the invention in a different form. Claims 12-14 find support in the specification, drawing figures, and the claims originally filed in the application and do not introduce new matter.

Formal Matters

The Official Action objected to the drawing figures, stating that Figures 6 and 7 should be provided with an indication designating them as prior art.

In reply, the drawing figures have been amended to overcome the Official Action's objection. Withdrawal of the objection to the drawing figures is solicited.

The Official Action objected to claim 5, stating that a colon should follow the word "comprising".

In reply, claim 5 is amended to obviate the objection. Withdrawal of the objection is respectfully requested.

The Official Action rejected claims 6, 8, and 9 under 35 USC 112, second paragraph as being indefinite.

In reply, claim 8 has been amended to depend from claim 7; claim 7 provides the antecedent basis to satisfy the elements recited in claim 8.

As to claims 6 and 9, it is firstly respectfully submitted that the specification has been amended, at page 10, lines 10-12, so that elements 21 and 22 refer to first and second welding portions, respectively, thereby bringing the passage into conformance with the remainder of the disclosure (e.g., see chart on page 6, lines 3-13).

It is also respectfully submitted that "welding allowance" is a term known in the art referring to a dimension of a material that is lost at the point of a weld.

See, for example, U.S. Patent 4,970,618, wherein claim 1 recites (in part) "boss portions having a welding allowance at a top end thereof... said welding allowances of said boss portions and inner bottom portions of said cylindrical portions being ultrasonically-welded to each other." The specification of U.S. Patent 4,970,618 discloses "a portion 17 of allowance of welding is formed at the tip portion of each of the bosses 15, and the bosses 15 are respectively inserted into the cylindrical portions 16 with the portions 17 of allowance for fusion facing downward, (column 2, lines 8-12)." "A disk cartridge is formed in such a manner that boss portions, each having a welding allowance at the top end thereof are projected from the surface of one of the cases thereof..." (column 2, lines 62-65).

See also Philips Resistance Welding Handbook (Philips Industrial (Philips Lamps Ltd.), Published by Philips Industrial (Philips Lamps), 1945) disclosing "On heavy sections where it attempted to flash weld from a cold condition a high transformer capacity would be necessary and a fairly long flash stroke which involves a substantial welding allowance," (page 50).

In the present application, welding allowance 19a is shown extending from the protruding portion 19 of the case 11 (page 9, line 20 to page 10, line 2; Figure 4(A)). The height of the welding allowance 19a is larger than that of a second welding allowance 19b (immediately to the left of 19a in Figure 4(A)).

This is possible because the pocket portion 28 is small (page 10, lines 7-9).

Figure 4(A), including welding allowances 19a and 19b, shows the apparatus prior to welding; in contrast, welding allowances 19a and 19b are absent from Figure 4(B), which illustrates the apparatus after welding (page 9, lines 11-12). It is respectfully submitted that this disclosure is in accordance with the term "welding allowance" as known in the art.

Accordingly, it is respectfully submitted that the term "welding allowance", as disclosed in the specification as amended, and as understood in the art, is clearly defined as the elements 19a and 19b having different dimensions illustrated in Figure 4(A), and therefore not indefinite as recited in claim 6.

Withdrawal of the rejection for indefiniteness is respectfully solicited.

Substantive Rejections

The Official Action rejected claims 5-9 under 35 USC 102(b) as being anticipated by Rosenberg (US 3,803,810; "ROSENBERG").

Alternatively, the Official Action rejected claims 5-9 under 35 USC 103(a) as being unpatentable over ROSENBERG.

The rejections are respectfully traversed for at least the reasons that follow.

It is firstly noted that claim 5 has been amended, as stated above. It is respectfully submitted that ROSENBERG does not teach or suggest the structure according to amended claim 5, wherein the partitioning member has a peripheral portion, the first welding portion welds the case and the cover together at a position proximate to a peripheral portion of the partitioning member, and the second and third welding portions each weld to the peripheral portion of the partitioning member.

On the contrary, ROSENBERG teaches a structure wherein a seam 4 is provided at a first peripheral portion of a partitioning member 22 bonding a main housing portion 2 and a housing cover portion 3, and a flange 18 bonded to a second peripheral portion of the partitioning member 22, the first peripheral portion and the second peripheral portion at opposite ends of the partitioning member 22 (column 8, line 65 to column 9, line 5; column 9, lines 17-28; Figure 3).

This teaching fails to teach or suggest the structure recited in amended claim 5.

It is also respectfully submitted that ROSENBERG fails to teach or suggest a second welding portion and a third welding region spaced apart across a length of the peripheral portion to form a pocket portion above the length of the peripheral portion, wherein the pocket portion is separated from a fluid flow through the partitioning member.

On the contrary, ROSENBERG teaches a fluid flow through the partitioning member 22 (see arrows passing through filter 22 in Figures 3 and 4) from a space beneath the partitioning member 22 into a chamber above partitioning member 22 and out the vent 25 (column 9, lines 24-40; column 10, line 59 to column 11, line 2).

It is therefore respectfully submitted that claim 5 is patentable over ROSENBERG.

It is also respectfully submitted that claims depending from claim 5 are patentable at least for depending from a patentable claim.

For example, it is respectfully submitted that claims 7 and 9 are patentable over ROSENBERG in their own right, in addition to being dependent from a patentable claim.

As to claims 7 and 9, the Official Action states that ROSENBERG teaches the partitioning member is a filter element, that the recitation of the apparatus being an automatic transmission oil filter is a recitation of intended use and does not further structurally limit the apparatus.

Applicants respectfully disagree. It is respectfully submitted that the filter elements disclosed by ROSENBERG are unsuitable for use as an automatic transmission oil filter, and further, ROSENBERG makes no teaching or suggestion of a structure of either the case or the partitioning member satisfying claims 7 and 9.

ROSENBERG is directed to a liquid-gas filter capable of separating gases and liquids and filter liquids and of venting the gases in any position of the filter, particularly adapted for medicinal applications where liquids must be filtered but air must be vented from the line (column 3, line 59 to column 4, line 2). The filter 22 is disclosed as a liquid-repellent filter configured such that gas entering the fluid chamber 14 can leave the chamber through either of liquid-repellent filters 22, 24, while liquid entering the chamber 14 must leave through the liquid-wetted filter 23 (column 9, lines 29-40).

This disclosure does not satisfy claims 7 and 9. There is no teaching or suggestion anywhere in ROSENBERG that filter 22 is suitable, for example, to filter particulates from transmission oil. On the contrary, ROSENBERG teaches the filter 22 as adapted for medical applications separating liquid from air. This teaching clearly teaches away from a structure required by the recitation of claims 7 and 9 of an automatic transmission oil filter.

Dependent claims 7 and 9 are therefore believed to be patentable in their own right, in addition to depending from a patentable claim 5.

Reconsideration and withdrawal of the rejection under §103 are respectfully requested.

It is further respectfully submitted that new claims 10-11 are patentable over ROSENBERG (see Figure 3), and that new

claims 12-14 are patentable for at least the same reasons set forth above as to claim 5.

Allowance of the claims is respectfully solicited.

From the foregoing, it will be apparent that applicants have fully responded to the August 6, 2008 Official Action and that the claims as presented are patentable. In view of this, applicants respectfully request reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, it is requested that the Examiner telephone the attorney for applicants at the number set forth below if the Examiner is of the opinion that further discussion of this case would be helpful.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- ☒ - a Replacement Sheet for Figures 6 and 7 of the drawings